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### REMARKS/ARGUMENTS

Claims 30–37 and 39–51 are pending in the present application, prior to entry of this amendment. All of these claims have been canceled in favor of a new set of claims that are believed to more clearly define over the references of record. (Claims 52–90 were canceled in previous amendments.) New claims 91–148 are presented for entry and consideration. Of these claims, claims 91, 114, and 131 are independent claims.

This application has been pending since July 11, 2000, and was the subject of an appeal to the Board of Appeals and Patent Interferences. Applicant filed its appeal brief on June 23, 2003. The case was unintentionally abandoned and revived. In the most recent Office Action of January 13, 2005, the Examiner reopened prosecution and issued new grounds for rejection.

In this regard, claims 30–37, 39–46, and 50–51 were rejected under 35 U.S.C. § 102(a) based on an alleged public use of the invention, premised on two articles about the so-called “PayPal” system. The references cited were, Reference U, “You’ve Got Money!”, June 2000, and Reference V, “Beaming Money by Email is Web’s Next Killer App,” November 16, 1999.

The Examiner also rejected certain dependent claims as unpatentable over a public use of PayPal, in view of an article, Bills.com, Reference W.

The Applicants have previously cited other references to PayPal, and directs the Examiner’s attention to the initial Information Disclosure Statement filed Jul 31, 2000 (document no. AT). Furthermore, Applicants are filing concurrently herewith another Information Disclosure Statement (IDS), which contains certain other references that Applicants wish to bring to the Examiner’s attention. Specifically, this concurrently-filed IDS contains a number of other articles that describe aspects of the PayPal system. (Collectively, the Examiner’s cited References U and V, together with the various other PayPal references in previously and concurrently-filed IDS, will collectively be referred to as “the PayPal References.”)

A copy of the Forms PTO/SB/08A (1 sheet) and PTO/SB/08B (3 sheets) from this IDS are attached hereto as Exhibit A, without the references themselves. The nonpatent references are too voluminous to be transmitted by facsimile and are being submitted by U.S. Mail concurrently herewith.

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Reconsideration of the rejection is respectfully requested in view of the foregoing amendments, the additional information submitted, and the following comments.

*Claim Rejections – 35 U.S.C. § 102*

Claims 30–37, 39–46, and 50–51 were rejected under 35 U.S.C. § 102(a) as based upon a public use of the invention, as ostensibly manifested by PayPal, as shown in References U and V.

These claims have all been canceled, in favor of new claims 91–148, which are believed to be novel and nonobvious in view of PayPal and the other references of record. The merits of these claims will be explained, and certain other previously cited art will be reviewed, to illustrate how the claims are patentable over the art.

*The Newly-Presented Claim Set*

The new independent claims 91, 114, and 131 are all directed to computer-implemented methods for effecting online payments, with claim 91 directed to a “money transfer” between a first party and a second party (i.e. making an online payment and/or requesting an online payment), claim 114 directed to making an online payment to a second party, and claim 131 directed to requesting an online payment from a second party. All of these claims are well described and supported in the specification and drawings, as will be annotated.

Claim 91 is directed to computer implemented method for providing a money transfer service between first party and a second party through a payment enabler system. The method includes steps of maintaining at the payment enabler system a database of registered users that have registered with the payment enabler system, the database comprising a plurality of records that include an email address and other account information including a default payment method and a default money receiving method. (See FIG. 5, step 570, as regards registered users database.)

The method further includes the step of maintaining at the payment enabler system an address book database for storing address book records comprising names associated with second parties with whom a first party may initiate a money transfer, each address book record

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including a name and an associated email address. (See FIG. 4; specification page 15, line 27 through page 17, line 12). In response to selection by a first party of an address book entry of a particular second party for purposes of initiating a money transfer with the selected second party, a step is carried out of retrieving the email address associated with the selected second party from the first party's associated address book records in the address book database. Then, the step is carried out of accessing the registered users database and determining whether the retrieved email address associated with the selected particular second party has a record in the registered users database. (See FIG. 6, step 630.) In response to a determination that the second party has no entry in the registered users database, a step is carried out of sending the second party a registration invitation email utilizing the retrieved email address to notify the second party that a transaction is pending and instructing the second party to register with the payment enabler system by accessing the payment enabler system. (See FIG. 6, step 650 for making a payment; FIG. 9, step 940 for requesting a payment, and associated text.)

In response to accessing of the payment enabler system by the second party after the registration invitation email, a step is carried out of conducting a user registration process that includes receiving registration information comprising an email address of the registering user, identification information, and a default money transfer method. (See FIG. 5 and associated text in the specification.) In response to receiving registration information from a registering user, a step is carried out of creating a database record in the registered users database including the registration information. Finally, a step is carried out of completing the transaction between the first party and the second party by the payment enabler transferring money between the first party and the second party utilizing a determined money transfer method.

The dependent claims associated with claim 91 are directed to various aspects such as, for example: having the first party provide security information (e.g. a question and answer) for authenticating a second party for receiving a payment (e.g. claims 92-94, 99-100); having the transaction comprise making a payment (claim 95) or requesting a payment (claim 96); completing a transaction in the event that a party is already a registered user (claim 97); providing a link in the invitation email to direct a registering user to the payment enabler system (claim 98); allowing selection of a default payment method and a default money

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receiving method (claim 101); providing a confirmation email to a registering user with a deep link to enable account activation (claim 102); enabling use of the default money transfer method or an alternative money transfer method (claims 103, 104, 105); storing additional information associated with a money transfer, including transaction type information and status information (claims 106, 107, 108); providing an account history display for a user (claim 109); providing an address book display with certain features (claim 110); and making use of a payment intermediary, to facilitate various forms of payment receipt from payors and various forms of money receipt by payees (claims 111, 112, 113).

Claim 114 is directed to a computer implemented method for making an online payment through a payment enabler system. Claim 114 has certain steps in common with claim 91, namely, the provision of the address book feature that allows a first party to select a particular second party from the address book for (in this case) making a payment, without regard to whether that party is registered with the payment enabler or not. Claim 114 further has steps for receiving security information (e.g. a question and an expected answer) from the first party, for provision to the second party upon registration process, for purposes of authenticating the second party for receiving a payment. Claim 114 also includes steps for receiving registration information from a registering user (i.e. in response to a registration invitation email), including a default money receiving method, and completing the payment from the first party to the second party using a determined money transfer method, which can be the default money receiving method (see dependent claim 121) or an alternative money receiving method (see dependent claim 122).

Claim 131 is directed to a computer implemented method for requesting an online payment through a payment enabler system. Claim 131 has certain steps in common with claim 91 and 114, namely, the provision of the address book feature that allows a first party to select a particular second party from the address book for (in this case) requesting a payment, without regard to whether that party is registered with the payment enabler or not. Claim 131 also includes steps for receiving registration information from a registering user (i.e. in response to a registration invitation email), including a default money payment method, and completing the payment from the second party to the first party using a determined money transfer method.

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which can be the default money payment method (see dependent claim 139) or an alternative money payment method (see dependent claim 140).

It is submitted that these various other aspects of the invention, when taken in combination with the features and aspects of claim 91, are novel, not obvious, and should be allowed.

### *The PayPal References*

The Examiner has relied upon References U and V for rejecting claim 30 and its associated dependent claims. For the record, the Applicants have located and submitted for consideration several other documents that relate to the PayPal system. As will be explained, the initial PayPal documents, including the additional PayPal documents (and certain other documents) in the concurrently-filed IDS do not disclose, teach or suggest the claimed aspects of the present invention, as set forth in the independent claims. In particular, the Examiner should note that these PayPal documents are third-party articles that do not provide any technical details of the operation of the PayPal system, are arguably not enabling as a reference, and, most importantly, do not disclose various claimed aspects of the inventions in the new claim set.

Perhaps the earliest PayPal document of record is Reference V, "Beaming Money by Email ..." Nov. 16, 1999. The examiner numbered the paragraphs in the copy of the article supplied with the Office Action. Paragraph 7 of this document says that, "After registering for the free service at [www.paypal.com](http://www.paypal.com), consumers simply enter the recipient's email address and a dollar amount. The money is debited from payor's credit card or bank account, and credited to the recipient. ... If the recipient is not yet a PayPal user, he or she simply registers on the Paypal.com site after receiving email notification, and is immediately credited with the amount in the new account. Funds may be withdrawn at any time by electronic transfer to a bank account or personal check from PayPal.com." (Emphasis supplied.)

Note that the counterpart first party ("consumer") must enter an email address, presumably into some form designed to make a payment. There is no address book. There are no details as to what information is displayed, or how this email address is "entered," or what the

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PayPal system does with this entered email address – other than generally saying that an email notification is provided to the second party.

Reference U, “You’ve Got Money!” is dated months later – in June 2000, and adds no further technical details. It says nothing about an address book, default payment methods, etc. Paragraph 2 of this reference states: “On the receiving end of the payment, recipients do not have to be registered with PayPal prior to having money sent to them. Instead, the receiver must fill out a form attached to the payment to access the money already waiting in a PayPal account in the receiver’s name. To withdraw money from the PayPal account, a consumer may provide the number of a bank account to which he would like the money moved, or have a check mailed out.” (Emphasis supplied.) Paragraphs 8 and 9 further state: “Although person-to-person payment models vary, the basic premise is that a consumer registers with an email payment company by providing either a credit card or a bank account number. With PayPal’s product, a customer registers for an account, in which money can be stored online. When an accountholder wants to send money to someone else, he simply fills out an email form with the fund recipient’s email address, the amount that’s being sent and an explanatory note, and then clicks the ‘send’ button. ... On the receiving end of the payment, recipients do not have to be registered with PayPal prior to having money sent to them. Instead, the receiver must fill out a form attached to the payment to access the money already waiting in a PayPal account in the receiver’s name.” (Emphasis supplied.)

It is unclear from Reference U what exactly is meant by the receiver having to fill out a form attached to the payment to access the money. This suggests that the recipient gets an email from the system that has some kind of attached form, but the nature and operation of this “form” is not specified. This actually teaches in a different direction from Reference V, by suggesting that if a recipient is not registered, they must “fill out a form attached to the payment to access the money.” Reference U is thus apparently different from Reference V, which suggests some form of registration process. (As an aside, it should be noted that the Applicants’ claims set forth specific and technical aspects of an online payment system, e.g. a registration process, specifying default money transfer methods, checking whether an address in an address book corresponds to an already-registered user, requesting and utilizing security information for authentication, and

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what information is obtained and/or provided, what happens in response to input of certain required information, etc.)

Notwithstanding this inconsistent picture of what PayPal actually is (or rather, was at the time this application was filed in July 200), neither of these inconsistent references teach the claimed inventions.

Several other PayPal documents are submitted for consideration in the concurrently-filed IDS, namely, references numbered 79, 82, 83, 84, 85, 86, 87, 88, 89, and possibly others. It is important to note – none of these additional references, taken alone or in combination with References U and V, teach the claimed subject matter.

In this regard, note that claim 91 has several elements or steps that are not disclosed, taught, or suggested by the PayPal References. For example, claim 91 is directed to a money transfer service that can be used both to make payments and request payments. The PayPal References do not teach that – as taught in the references it is just one-way payment system. Claim 91 also includes an address book database that stores address book records comprising names associated with second parties with whom a first party may initiate a money transfer. The PayPal References describe a system where a person “fills out an email form with the fund recipient’s email address.” There is no provision or suggestion of providing the capability of having multiple potential payees, without regard to whether such persons have previously registered or not.

Claim 91 also includes a step for, in response to selection of an address book entry of a second party for purposes of initiating a money transfer, retrieving the email address associated with the selected second party from the first party’s associated address book records in the address book database. This retrieved email address is used for accessing a registered users database and determining whether the retrieved email address associated with the selected particular second party has a record in the registered users database. Further still, claim 91 includes a step for, in response to a determination that the second party has no entry in the registered users database, sending the second party a registration invitation email utilizing the retrieved email address to notify the second party that a transaction is pending and instructing the

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second party to register with the payment enabler system by accessing the payment enabler system.

No such operation is taught in the PayPal References. Granted, the aspect of sending an unregistered party an email "notification" to advise that a payment is pending is taught in the PayPal References. This alone, however, is insufficient to reject the present claims, as the teachings are incomplete. The PayPal References stop here, and do not contemplate "money transfers" of both payment and money request, and do not suggest anything but a form filled out by entry of an email address. The PayPal References teach (and divergently and inconsistently so, as mentioned above) that a recipient must fill out a form attached to the payment (presumably an email sent to them, although the reference is not clear). This is clearly not an address book functionality.

It is submitted that the steps in claim 91 of providing a money transfer service that contemplate both payments and money requests, and providing an address book containing address book records of possible second parties (without regard to whether such parties have registered with the system or not), coupled with utilizing a selected address book entry to determine if a second party is registered or not and send a registration invitation email only if not registered, is not disclosed, taught or suggested in any of the references of record.

Independent claim 114 is directed to the notion of making a payment to a selected second party from a first party's address book. Claim 114 also includes similar steps of providing an address book database, retrieving an email address of a selected party in the address book database, determining from this retrieved email address whether the selected second party has a record in the registered users database, etc. Claim 114, however, has further steps that are believed novel – in response to a determination that the second party has no entry in the registered users database, receiving security information from the first party including predetermined expected information for purposes authenticating the second party for receiving the payment.

As in claim 91, the second party is sent a registration invitation email if not previously registered. However, claim 114 further includes the step of, in response to accessing of the payment enabler system by the second party after the registration invitation email, conducting a

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user registration process including steps for receiving registration information comprising an email address of the registering user, identification information, a default money receiving method, and a response corresponding to the first party's security information. As described in the specification and as set forth in various dependent claims, this security information may comprise a question and expected answer, to be used to authenticate the second party for receipt of the payment. Further still, claim 114 includes the step of allowing a registering user (second party) to specify a default money receiving method. The payment is completed by a determined money transfer method, which can be the default money receiving method (see dependent claim 121) or an alternate money transfer method (see dependent claim 122).

None of these aspects of claim 114, in combination, are disclosed, taught, or suggested by the PayPal References, alone or in combination with other references.

Independent claim 131 is directed to the notion of requesting a payment from a selected second party in a first party's address book. The PayPal References teach nothing about a system wherein a party can request a payment from another party.

As in claims 91 and 114, claim 131 also includes steps of providing an address book database, retrieving an email address of a selected party in the address book database, determining from this retrieved email address whether the selected second party has a record in the registered users database, etc. As in claims 91 and 114, the second party is sent a registration invitation email if not previously registered. Claim 131, however, has further steps that are believed novel. Claim 131 further includes the step of, in response to accessing of the payment enabler system by the second party after the registration invitation email, conducting a user registration process comprising steps including receiving registration information comprising an email address of the registering user, identification information, and a default money transfer method. The payment is completed by a determined money transfer method, which can be the default money payment method (see dependent claim 139) or an alternate money payment method (see dependent claim 140).

None of these aspects of claim 131, in combination, are disclosed, taught, or suggested by the PayPal References, alone or in combination with other references. The address book functionality, which is an element of all three independent claims, allows selection of a particular

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second party from a first party's address book without regard to whether such parties have previously registered, and informs the subsequent generation and transmission of a registration invitation email. This feature, when taken in combination with the other steps of the claimed methods, is believed novel and nonobvious, and thereby provides a useful and beneficial online payment system that the PayPal References simply do not address (no pun intended).

For the foregoing reasons, it is submitted that the claims as now presented are not anticipated by the PayPal References, as the claims patentably define over such references, without regard to whether such references actually suffice to show public use as required under 35 U.S.C. § 102(a). Because the claims are shown to be patentable over the PayPal References, it is not necessary to address the sufficiency of the references as a showing of prior public use, but Applicants submit that the references are technically insufficient and inadequate to disclose, teach or suggest the claimed aspects of claims 91, 114, and 131, and this issue is hereby expressly preserved for appeal if necessary.

#### *Claim Rejections – 35 U.S.C. § 103*

In addition to the rejection under 35 U.S.C. § 102(a), the Examiner rejected dependent claims 47–49 as unpatentable over a public use of PayPal in view of Reference W, "Bills.com". Claims 47–49 have been canceled, so further response is believed unnecessary.

#### *Other References of Record From the Appeal*

The Applicants and the undersigned have reviewed this voluminous record and previous filings, especially including the principal references relied upon making a rejection of previous claims in this case, which rejections were appealed and discussed in the appeal brief filed on June 23, 2003. It is believed that the claims now presented are patentable over all of such references, as well.

The *Lamm* patent (6,078,907) merely discloses a method and system by which registered payees and a registered payor exchange billing information and payments by exchanging electronic files, which are free of sensitive and private information (see *Lamm*, Col. 4, lines 8–20). *Lamm* requires the intended recipient of funds (the payee or "billing party") to be

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previously registered with the "processor computer" so that the payor (or "billed party") may select potential payees during the registration process of the payor (*see Lamm*, Col. 8, lines 56-60; Col. 9, lines 37-40; Col. 10, lines 9-11). The claims now presented differ from such a system.

The *Jalili* patent (6,088,683) merely discloses a method for providing, over a secure communication path, such as a telephone system, authorization for the completion of a transaction initiated over an insecure communication path, such as the Internet (*see Jalili*, Abstract). The teaching of *Jalili* is that a customer (i.e., payor) be registered with a processing center, which administers authorizations and handlings of payments to merchants (Col. 1, lines 59-66), without specific teaching on the subject of merchant registration.

The *Payne* patent (5,909,492) merely illustrates a conventional process by which an individual is enabled to purchase an item through an electronic commerce website. *Payne* teaches that a buyer computer contacts a payment computer with a "URL A," which includes a merchant account identifier and a payment URL authenticator. The authenticator is defined by a key shared by the merchant and the operator of the payment computer (Col. 5, lines 26-47). Thus a relationship exists between the merchant and the operator of the payment computer. That relationship pre-exists any transaction-specific data from the buyer computer. In other words, a computer server is intermediate a merchant (payee) and a buyer (payor), and the payee is already registered with the intermediate computer server prior to the initiation of any specific transaction involving a payor. As discussed above, the present claims define a distinctly different system and operation thereof.

The *Kausik* patent (6,263,446) is directed merely to a method and system by which a system user is able to freely roam and authenticate himself with a central computer when the system user is not at his normal computer (i.e., one that has the system user's authentication credentials maintained in storage) and without requiring the system user to carry and use a hardware token, such as a smart card. While *Kausik* may be germane to authentication methods (*see* Col. 4, lines 21-24), Applicant respectfully submits that *Kausik* does not provide teachings germane to a system and methods as now claimed.

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*Conclusion*

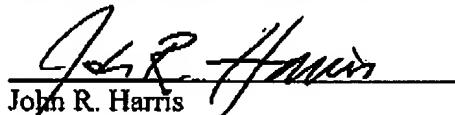
For the foregoing reasons, it is respectfully submitted that independent claims 91, 114, and 131, as amended, and the remaining dependent claims, have utility, are novel, and are non-obvious in view of the references and should be allowable. The foregoing is presented as a full and complete response to the Office Action mailed January 13, 2005, and is believed to have placed all claims in condition for allowance. Such action is courteously solicited. If any issues remain that can be resolved by telephone, the Examiner is respectfully requested to contact the undersigned at 404-233-7000.

Applicant submits this Amendment with a request for a two-month extension of time in which to file. A PTO-2038 Credit Card Payment Form is transmitted herewith authorizing payment in the amount of \$450.00 for a two-month extension of time. Applicant respectfully requests that the Office notify the undersigned if there are any additional fees due that have not been identified or included herewith.

It is now believed that the application is in condition for allowance and such allowance is respectfully requested.

Respectfully submitted,

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